



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,100	12/21/1999	KNUT S. GRIMSRUD	10559/111001	7001

20985 7590 04/24/2003

FISH & RICHARDSON, PC  
4350 LA JOLLA VILLAGE DRIVE  
SUITE 500  
SAN DIEGO, CA 92122

EXAMINER

ELMORE, STEPHEN C

ART UNIT	PAPER NUMBER
----------	--------------

2186

DATE MAILED: 04/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/471,100

Applicant(s)

GRIMSRUD, KNUT S.

Examin r

Stephen Elmore

Art Unit

2186

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5,13-18,25-28 and 31-60 is/are allowed.
- 6) ☒ Claim(s) 7-12,19-24,29,30 and 61-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This Office action is in response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed February 7, 2003, paper number 11.
2. The After-Final amendment filed January 7, 2003, paper number 8, has been entered into the application and has been considered with the following effect.
3. Claims 1, 13 and 25 were amended and new claims 46 to 72 were added by the amendment.
4. Claims 1-72 remain for examination.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 61-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, independent claims 61, 65 and 69 are directed towards a method, medium and apparatus for reading data from a storage medium, including an element "demand data", however, the presence of the second instance of "demand data" terminology, in claim 61, at lines 7 and 8, suggests there is a "second" (new) demand data participating in the practice of the invention, however, the scope of the disclosure teaches only a single "demand data" element

Art Unit: 2186

participating in the practice of the instant invention, therefore, the claims are not enabled for the scope of a second, new demand data element;

- b. the same problem exists for independent claim 65 at lines 8 and 9;
- c. the same problem exists for independent claim 69 at lines 8 and 9;
- d. claims 62-64, 66-68 and 70-72 inherit the deficiencies of the independent claim from which they depend.

***Claim Rejections - 35 USC § 102***

- 7. The rejection of claims 1, 13 and 25 are *withdrawn* due to the amendment.
- 8. The previous indication of allowability of claims 7-12, 19-24, 29 and 30 is *withdrawn* in view of the following newly discovered prior art.
- 9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 10. Claims 7-12, 19-24, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al., US Patent 6,085,287.

O'Neil teaches the claimed method, program on a medium (i.e., instructions being executed by a processor of the computer system), and apparatus (claims 7, 19 and 29) for reading data from a storage medium of a disk drive, comprising:

as to the limitations of claims 7, 8, 9, 10, 19, 20, 21, 22, 29, 30,

- a. reading data from a first location on the storage medium in response to a command requesting data at a second location on the storage medium,

Art Unit: 2186

and

b. reading data from the second location on the storage medium in response to the command, the first location preceding the second location in a direction of movement of the storage medium during reading,

these are taught by the reference, see Figs. 2 and 4, and col. 3, line 59 - col. 5, line 12, especially, at col. 4, lines 42-47, as the functionality "second disk read" which is a "read-around" reading data before the starting point (i.e., claims 8 and 20), and after the end point, (i.e., claims 9, 10, 21 and 22) of the immediately requested data;

c. as to claims 11 and 23, the command being received from a computer program executing on the host processing device is taught as the application program, element 12;

d. as to claims 12 and 24, storing data read from the first and second locations in a memory on the host processing device is taught as storing the data in the cache, element 18, which is internal to the host processing device that is the computer system, col. 2, lines 59-60.

#### ***Allowable Subject Matter***

11. Claims 1-5, 13-18, 25-28, and 31-60 are allowable over the prior art of record.

12. Claims 61-72 contain allowable subject matter over the prior art of record, however, are not presently allowable due to the 112, first paragraph rejection.

#### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2186

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen C. Elmore whose telephone number is (703) 308-6256.


The examiner can normally be reached on Mon-Fri from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt M. Kim can be reached on (703) 305-3821. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications, (703) 746-7240 for Non-Official/Draft communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Stephen Elmore  
Examiner  
Art Unit 2186  
April 17, 2003



MATTHEW KIM  
SUPERVISORY PATENT EXAMINER  
BIOLOGY CENTER 2100